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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,514	02/11/2004	Kerry Zang	073275.0163	5263
5073	7590	06/12/2007		
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			EXAMINER MILLER, CHERYL L	
			ART UNIT 3738	PAPER NUMBER
			NOTIFICATION DATE 06/12/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/777,514

Applicant(s)

ZANG ET AL.

Examiner

Cheryl Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1, 3-8, 12-17, 19-23, 27-33, and 36-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 40-69 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant has claimed “a majority” throughout the claims. For example, in claim 40, applicant recites, “thread...extending at least a majority of the length of the body”, and “a majority of the at least one thread having a substantially constant thread height”. No support was found in the specification for all the features over “a majority” of the device. Majority defined as more than 50 percent. Applicant does not have support for all features covering 50+ percent –100 percent. The applicant is reminded that the elected embodiment is shown in figures 1A-1C. A “majority” is considered new matter throughout all the claims.

Further, claims 48 and 63 recite, “ratio of the crest width to the pitch is between 0.25 and 0.4”. This is not the range found recited in the specification and thus is being considered new matter.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 40-45 and 55-60 are rejected under 35 U.S.C. 102(b) as being anticipated by Crombie (US 5,961,524, cited previously). Crombie discloses a implant (10; fig.1) *capable* of being placed in the sinus tarsi of a human, the implant (10) comprising a tapered body (root), a continuous uninterrupted thread (20) which is external surface is conically tapered with respect to the axis (see alpha) and the thread (20) having a constant height (col.4, lines 20-23) and pitch (col.4, lines 28-30). Crombie discloses the taper of the body to equal the taper of the thread (inherently, since the height is constant), wherein the taper is between 15 and 20, preferably 18 degrees (col.4, lines 5-10, range disclosed encompasses claimed value). Crombie discloses an engagement (24) in the trailing end of the body for a tool.

Claims 40-42 and 55-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Bailey et al. (US 5,607,304). Bailey discloses a implant (either 16 or 17) *capable* of being placed in the sinus tarsi of a human, the implant (16 or 17) comprising a tapered body (see fig.1, 2), a continuous uninterrupted thread (either 22 or 24) which is external surface is conically tapered with respect to the axis and the thread having a constant height and pitch (figures show the height to be constant; col.2 line 59-col.3 line 7). Bailey discloses the taper of the body to equal the taper of the thread (seen in figures as so, clearly in fig.2).

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Claims 40-42 and 55-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartos et al. (US 5,704,750). Bartos discloses a implant (16) *capable* of being placed in the sinus tarsi of a human, the implant comprising a tapered body (second segment), a continuous uninterrupted thread (36) which is external surface is conically tapered (in second segment; col.2, lines 45-47) with respect to the axis (18) and the thread (36) having a constant height (col.3, lines 10-14; fig.1) and pitch (col.3, lines 1-6). Bartos discloses the taper of the body to equal the taper of the thread (inherently since the thread height is constant; col.3, lines 38-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 46-54 and 61-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crombie (US 5,961,524, cited previously). Crombie disclose an implant having all features substantially as claimed, conical body, tapered threads, constant thread height and pitch, taper angle, etc (see above). Crombie does not however disclose specific values for the width, pitch, height, and thread angle (thus their ratios) as claimed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the dimensions claimed, since when the general conditions of a claim are disclosed in the prior art (constant thread height and pitch, with conical shape), it is not inventive to discover the optimum or workable ranges by routine experimentation. *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Miller whose telephone number is (571) 272-4755. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm.

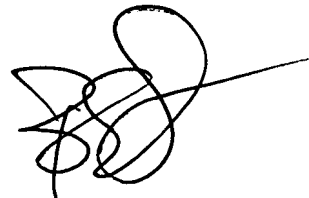
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4755. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Cheryl Miller



BRUCE SNOW
PRIMARY EXAMINER